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Alexandria, VA 22313-1450
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1802 VALLEY CURVE ROAD
MENDOTA HEIGHTS, MN 55118

COPY MAILED

JUN 19 2008

OFFICE OF PETITIONS

In re Application of	:	
Gerfast	:	
Application No. 10/733,944	:	DECISION
Filed: 12 December, 2003	:	
Attorney Docket No. (None)	:	

This is a decision on the petition, filed on 7 April, 2008, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application, and in the alternative, a petition to revive under 37 C.F.R. §1.137(b) and alleging unintentional delay.

The petition under 37 C.F.R. §1.181 is **DISMISSED**, and the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision should be filed **within two (2) months** from the mail date of this decision. *Note* 37 C.F.R. §1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment"; or, in the alternative, as a "Renewed Petition under 37 C.F.R. §1.137(b) to Revive an Application Abandoned Due to Unintentional Delay." (Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 C.F.R. §1.137(b). A petition alleging "unintentional" delay under 37 C.F.R. §1.137(b) must be accompanied by the petition fee, and Petitioner always should refer to the Office website (<http://www.uspto.gov/main/howtofees.htm>) to ensure submission of the proper fees. (A specific

fee is not stated here because fee amounts change and there is no way to know when Petitioner will submit materials for filing.))

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

A proper showing for a petition under 37 C.F.R. §1.181 requires at the very minimum:

- A statement from practitioner stating that the Office action was not received by the practitioner;
- A statement from the practitioner attesting to the fact that a search of the file jacket and docket records for the application indicates that the Office action was not received with a copy of those docket records; and
- A **brief** statement of the calendaring process and a copy of the due-date (calendar) docket record(s) where the nonreceived Office action would have been scheduled for reply had it been received must be attached to and referenced in the practitioner's statement.

Alternatively:

- A statement from practitioner stating that the reply was timely submitted by the practitioner;
- Copies of all papers submitted as and/or in support of that reply, with/and a copy of the date-stamped receipt card, Office FAX receipt acknowledgement (not simply Petitioner's FAX transmittal), or EFS receipt acknowledgment from the Office, along with practitioner's attestation as to the correctness/completeness of his/her records.

The showing(s) must include that of the person(s) with first-hand knowledge and an acknowledgment by the Petitioner that he/she has reviewed that information in compliance with his/her duty of candor to the Office.

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR §1.137 was unintentional, the Director may require additional information. See MPEP §711.03(c)(II)(C) and (D).

It appears that Petitioner has not satisfied the requirements of the regulation, to wit: The instant petition lacks a sufficient fee.

(It appears that as of this writing the petition fee specified is \$770.00 and the former balance of \$60.00 due for the extension of time is now \$65.00 because the fee was increased from \$225.00 to \$230.00, however, Petitioner always should review the fee schedule set forth at the Office website

(http://www.uspto.gov/web/offices/ac/qs/ope/fee2007september30_2008july01.htm#petition) to ensure proper payment.)

The Office has included herewith a printout of fees submitted by Petitioner, as he has requested.

If Petitioner wishes to observe the status of the instant application, Petitioner may obtain a Customer Number (*see*: <http://www.uspto.gov/ebc/portal/register.htm>) and associate that Customer Number with the instant application .

BACKGROUND

The record reflects that:

Applicant, failed to reply timely and properly to the non-final Office action (copy enclosed) mailed on 20 May, 2005, with reply due absent an extension of time on or before 20 August, 2007.

Thereafter:

- Petitioner's 6 June, 2005, amendment was followed by the 28 March, 2006, Notice of Non-Compliant Amendment. (All documents discussed herein previously were provided.)
- Petitioner's 2 April, 2006, amendment was followed by the 16 June, 2006, Notice of Non-Compliant Amendment.
- Petitioner's 23 June, 2006, amendment was followed by the 12 June, 2007, Communication.
- Petitioner's 27 June, 2007, amendment was followed by the 27 June, 2007, Notification of Fee Due.

Petitioner is cautioned to consult the Office website (www.uspto.gov) to ascertain the amount of fees due under the current Fee Schedule and ensure that passage of time between Notice and reply does not trigger a requirement for additional extensions if available.

- the Office mailed the Notice of Abandonment on 25 February, 2008;

- on 3 March, 2008, Petitioner filed the instant petition with, *inter alia*, an averment that replies had been timely and properly filed to non-final Office action, and reasserting an earlier complaint that the “delay was at the PTO”—and ignoring that the extension of time requirement was to make timely Petitioner’s reply under the then-current Fee Schedule (Petitioner again is cautioned to consult the Office website (www.uspto.gov) to ascertain the amount of fees due under the current Fee Schedule and ensure that passage of time between Notice and reply does not trigger a requirement for additional extensions if available)—thus, Petitioner’s showing does not conform to the showing requirements set forth in the guidance of the Commentary at MPEP §711.03(c)(I)(A) and (B) (as to non-receipt or timely filing, respectively (see: the discussion at: [http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03 c](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03_c))).

Thus, as to the petition to withdraw the holding of abandonment, Petitioner lacks herein: a proper showing as set forth in guidance in the Commentary at MPEP §711.03(c), and discussed above.

The guidance in the Commentary at MPEP §711.03(c) sets forth the showing requirements for overcoming the presumptions herein.¹

¹ The guidance in the Commentary at MPEP §711.03(c) as to non-received Office actions and timely filed replies is as follows:

A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant’s representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner **>describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner’s record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner’s record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.<

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm’r Pat. 1988).

B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed

37 CFR 1.10(c) through 1.10(e) and 1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 CFR 1.10(c), (d), (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the “Express Mail” date.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

(*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," alternative "A Reply Was Timely Filed"; *see also*: "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 *Official Gazette* 53 (November 16, 1993).)

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. *See* MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, *see* 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

37 CFR 1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 CFR 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. *See* MPEP § 512.

C. Treatment of Untimely Petition To Withdraw Holding of Abandonment

37 CFR 1.181(f) provides that, *inter alia*, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may require a terminal disclaimer as a condition of granting an untimely petition to withdraw the holding of abandonment.

² *See* supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. *See Changes to Patent Practice and Procedure*, 62 *Fed. Reg.* at 53160 and 53178, 1203 *Off. Gaz. Pat. Office* at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.³ (See, also, the commentary at MPEP §711.03(c)(I)(A) and (B).)

And the regulation requires that relief be sought within two (2) months of the act complained of.

The petition fails to satisfy all of the above-stated requirements in that Petitioner failed make the showing required.

Allegations as to
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

The petition fails to satisfy all of the above-stated requirements in that Petitioner failed pay the proper petition fee (as set forth above)—and Petitioner is reminded of the previous balance due for an extension of time (as discussed above)..

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.181 is **dismissed**, and the petition under 37 C.F.R. §1.137(b) is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

³ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Application No. 10/733,944

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: (571) 273-8300
Attn: Office of Petitions

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

Notice of Fee Due

Date:

06-27-07

Application Number:

10,733,944

A fee is due for the attached document for the reason indicated below. Please check the application for the appropriate authorization to charge a deposit account. If an authorization is present, please charge the appropriate fee*. If an authorization is not present, notify the application of the fee deficiency.

***If the fee due is for any of the filing fees, check for authorization to charge the surcharge. If authorization is present, charge the surcharge for late payment of the filing fees as well.**

☐ Insufficient payment by check or money order.

☐ Insufficient funds in deposit account _____.

☒ Insufficient payment by credit card.

☐ Declined credit card.

☐ No authorization to charge a deposit account.

Fee code(s) to be applied:

2252

225

Amount in holding fee code:

1622

2622

1999

165

Total remaining due from applicant:

60

RAM Operator

E. J. A

RAM Fee History
Query
Revenue Accounting and Management

Name/Number: 10733944

Total Records Found: 5

Start Date: Any Date

End Date: Any Date

Accounting Date	Sequence Num.	Fee Type	Fee Code	Fee Amount	Mailroom Date	Payment Method
04/08/2008	00000003	<u>1</u>	<u>2452</u>	\$255.00	04/07/2008	CC
06/27/2007	00000006	<u>1</u>	<u>2252</u>	\$165.00	06/27/2007	CC
06/26/2006	00000070	<u>1</u>	<u>2251</u>	\$60.00	06/23/2006	CC
12/16/2003	00000047	<u>1</u>	<u>2001</u>	\$385.00	12/12/2003	CK
12/16/2003	00000048	<u>1</u>	<u>2202</u>	\$18.00	12/12/2003	CK
